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Paper No. 32

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. BERNHARDT

Appeal No. 2002-0962
Application No. 09/017,959

HEARD: Nov. 5, 2003

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

David A. Bernhardt (appellant) appeals from the examiner's final rejection of claims 17-28, all the claims currently pending in the application.

This is the second appeal to this Board involving the present application. In a decision mailed January 30, 2001, a merits panel of this Board affirmed the examiner's rejection of claims 1-16, all the claims then pending in the application, under 35 U.S.C.

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§ 102(b) as being anticipated by U.S. Design Pat. 97,360 to Stevens, but reversed the examiner's rejection of claims 1-16 under the second paragraph of 35 U.S.C. § 112.

Appellant's invention pertains to a device to be positioned on a bowler's index finger to enable the bowler to impart spin to a bowling ball. The claims on appeal are reproduced in Appendix A of appellant's main brief. Independent claim 17 is representative of the appealed subject matter and reads as follows:

17. A bowling accessory, comprising:

a mechanism for retaining the accessory to a bowler's finger;

a pad having one or more projections for contacting a bowling ball, said pad associated with said retaining mechanism, and said pad having an arcuate surface, said projections having desired configuration such that tips of said projections define a curve which has a curvature substantially like a curvature of the bowling ball when force is exerted by the bowler on the ball, the projections flatten providing a larger surface to grip the ball enabling the bowler to better initiate rotation as the bowling ball is released.

The sole reference applied in the final rejection is:

Stevens¹

Des. 97,360

Oct. 29, 1935

¹This is the same Stevens patent applied against the claims in the prior appeal.

Claims 17-28 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Stevens.²

Reference is made to appellant's main and reply briefs (Paper Nos. 25 and 27) and to the final rejection and examiner's answer (Paper Nos. 20 and 26) for the respective positions of appellant and the examiner regarding the merits of this rejection.

Discussion

At the outset, appellant's statement that claims 17-20 stand or fall together and that claims 21-28 stand or fall together is not reflective of the arguments made by appellant in the main and reply briefs regarding the merits of the examiner's anticipation rejection of the appealed claims. Rather, appellant has argued the examiner's anticipation rejection without reference to any particular claim. Thus, the appealed claims will stand or fall as a group. See *In re Wiseman*, 596 F.2d 1019, 1021-22, 201 USPQ 658, 660 (CCPA 1979); *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979); *In re Hellsund*, 474 F.2d 1307, 1309-10, 177 USPQ 170, 172 (CCPA 1973). For purposes of this appeal, we consider independent claim 17 as representative of appellant's

²In the final rejection, claims 17-28 were also rejected under 35 U.S.C. § 112, second paragraph, however, this rejection has since been withdrawn. See pages 4 and 6 of the answer.

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claimed subject matter, and will decide the appeal on the basis thereof, with claims 18-28 standing or falling therewith.

The test for anticipation is whether a prior art reference discloses every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The law of anticipation does not require that the reference "teach" what appellant teaches; all that is necessary is that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

We consider that the Stevens patent, which discloses a finger toothbrush, meets these requirements. Considering the Stevens reference in relation to the structure recited in claim 17, Stevens discloses a mechanism in the form of a body with a central bore for retaining the device on a wearer's finger, a pad at the bottom of the device (as shown in Figs. 1, 2 and 3) having one or more projections and associated with the retaining mechanism, the pad having an arcuate surface as shown in Fig. 2. As for the recitations in claim 17 that the projections are configured "such that tips of said projections define a curve which has a curvature substantially like a curvature of the bowling ball when force is

exerted by the bowler on the ball" (emphasis added) and that the projections "flatten providing a larger surface to grip the ball enabling the bowler to better initiate rotation as the bowling ball is released," the examiner states on page 3 of the final rejection (Paper No. 20):

While it can be argued that one is not certain of the material of the projections in Stevens, it is clear that they are not rigid since they are intended to be used on brushing teeth which would require some degree of softness. It follows that placing force on the projections of any type of brush by an object (such as a bowling ball) would force them to flatten in compressed and/or bent over fashion.

Appellant does not specifically disagree with the examiner's position that the projections of Stevens "are not rigid" and are required to have "some degree of softness" based on their intended use for brushing teeth. Appellant also does not specifically disagree with the examiner's position that placing force on the projections of a brush "by an object (such as a bowling ball) would force them to flatten in compressed and/or bent over fashion." Rather, appellant is understood to argue on page 4 of the main brief and page 1 of the reply brief that Stevens does not illustrate, disclose or suggest that the projections of Stevens are configured such that their tips would define a curve having a

curvature substantially like a curvature of a bowling ball when force is exerted by the bowler on the ball.

Admittedly, Stevens does not expressly disclose or describe that the projections are configured such that tips define a curve which has a curvature substantially like a curvature of a bowling ball when force is exerted by a bowler (wearer) on the ball, as recited in claim 17, or that the projections would flatten providing a larger surface to grip a bowling ball enabling a bowler (wearer) to better initiate rotation as the bowling ball is released, as also recited in claim 17. However, "a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it." *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999). The above-quoted statement from page 3 of the final rejection (Paper No. 20) is, in effect, a finding by the examiner that the projections of Stevens are configured such that they would inherently define a curvature substantially like the curvature of a bowling ball "when force is exerted by the bowler [wearer] on the ball" as called for in claim 17, and such that they would inherently be capable of flattening in the manner called for in claim 17. Given the structure and intended use of Stevens, we consider this finding to be

reasonable.³ The burden then shifted to appellant to shown that the Stevens structure did not inherently possess the limitations in question, *In re Schreiber*, 128 F.3d at 1477, 144 USPQ2d at 1432, but no evidence to that effect has been presented.

Appellant argues in the reply brief (pages 1-2) that the limitation of configuring the projections such that they define a curvature like that of a bowling ball when force is exerted by a bowler on the ball is not inherent, citing *In re Weiss*, 26 USPQ2d 1885 (Fed. Cir. 1993) for the proposition that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *In re Weiss* is an unpublished opinion and therefore is not citable as precedent. In any event, the proposition for which *Weiss* is cited does not mandate a contrary conclusion, but rather is consonant with the principles of inherency developed by case law. See, for example, *In re*

³The examiner also found (answer, page 5) that "Fig. 2 of Stevens clearly shows projections with 'a curvature substantially like a curvature of the bowling ball' (cl. 17, ln. 6)," a finding with which we do not agree. This circumstance is of no moment, however, in that a finding that the projections of Stevens have a curvature substantially like the curvature of a bowling ball independent of their being pressed by the bowler against the ball is not required in order to sustain the standing rejection of the appealed claims.

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Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971) where the Court stated:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In the present case, the examiner's findings relative to the nature of the projections of Stevens constitute sound technical reasoning that establishes the reasonableness of the examiner's belief that the functional limitations of claim 17 are inherent characteristics of the reference device, which reasoning, on the record before us, stands uncontroverted by appellant.

Appellant also argues (reply brief, page 2) that Stevens does not inherently disclose appellant's invention because Stevens does not teach the result of applying spin on a bowling ball. This argument fails because, as noted above, the law of anticipation does not require that the reference "teach" what appellant teaches; all that is necessary is that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d at 772, 218 USPQ at 789.

Concerning the functional limitations argued by appellant, as stated by the Court in *Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432, a patent applicant is free to recite features of an apparatus either structurally or functionally, but choosing to define an element functionally, i.e., by what it does, carries with it the risk of having the functionally recited element asserted to be critical for establishing novelty to be an inherent characteristic of the prior art. In this case, as in *Schreiber*, we have considered the functional limitations of the claims on appeal argued by appellant⁴ and agree with the examiner that they do not lend patentable weight to the presently claimed subject matter and that such limitations are in fact inherent characteristics of the device of Stevens.

Finally, appellant argues (main brief, page 4; reply brief, page 2) that the disclosure of Stevens is not sufficient to have placed the claimed invention in possession of a person of ordinary skill in the art. We do not agree, since we consider that Stevens would put one of ordinary skill in possession of the *structure* recited in, for example, claim 17, which is all that is required

⁴For example, the requirement of claim 17 that the tips of the projections define a curve which has a curvature substantially like a curvature of the bowling ball when force is exerted by the bowler on the ball.

for anticipation under § 102(b). Stevens, being a design patent, does not contain a detailed description of the device shown in its drawings, but that does not impair its ability to anticipate appellant's claims, since a claimed invention may be anticipated or rendered obvious by a reference drawing. *In re Meng*, 492 F.2d 843, 847, 181 USPQ 94, 97 (CCPA 1974). See also *In re Aslanian*, 590 F.2d 911, 913, 200 USPQ 500, 502 (CCPA 1979) ("numerous decisions have indicated that design patents can be properly cited as the basis for an anticipation rejection of claims in an application for a utility patent"). Since, for the reasons discussed above, Stevens expressly or inherently discloses all the limitations of claim 17, we conclude that claim 17 is anticipated by Stevens.

Accordingly, the anticipation rejection of claim 17 will be sustained. Likewise, the anticipation rejection of claims 18-28 will also be sustained since the appealed claims stand or fall as a group.

Recommendation Pursuant to 37 CFR § 1.196(c)

Our decision *supra* affirming the examiner's anticipation rejection is predicated on the fact that appellant's claims call for the tips of the projections to define a curve which has a curvature substantially like a curvature of a bowling ball when force is exerted by the bowler on the ball, a claim interpretation

that was conceded by appellant's counsel at oral hearing to be correct. However, it is our view that a different outcome would result if the claims were amended to set forth that the tips of the projections define a curve which has a curvature substantially like a curvature of a bowling ball independent of a force being exerted by the bowler on the ball.⁵ In light of this and under the provisions of 37 CFR § 1.196(c), we recommend that the standing anticipation rejection based on Stevens shall be overcome if claims 17 and 21 are amended as follows (with underlining indicating additions and bracketing indicating deletions)⁶:

17. A bowling accessory, comprising . . .

a pad having one or more projections for contacting a bowling ball, said pad associated with said retaining mechanism, and said pad having an arcuate surface, said projections having desired configuration such that tips of said projections define a curve which has a curvature substantially like a curvature of the bowling ball, and when force is exerted by the bowler on the ball[,] the projections flatten providing a larger surface to grip the ball enabling the bowler to better initiate rotation as the bowling ball is released.

21. A bowling finger grip, comprising . . .

⁵Support for this condition of the tips of the projections is found at page 3, lines 17-19, of appellant's specification.

⁶Appellant's counsel at oral hearing was understood to be amenable to such changes.

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a gripping surface on said tubular member, a plurality of gripping members on said gripping surface for contacting a bowling ball, said gripping surface being curved, said gripping members comprising projections having desired configurations such that tips of said projections define a curve which has a curvature substantially like a curvature of the bowling ball, and when force is exerted by the bowler on the ball[,] the gripping members flatten providing a larger surface to grip the ball enabling the bowler to better initiate rotation as the bowling ball is released.

Summary

The decision of the examiner rejecting claim 17-28 as being anticipated by Stevens is affirmed.

A recommendation pursuant 37 CFR § 1.196(c) as to how the above affirmed rejection can be overcome is made.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR § 1.196(c)

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence. Stubb

LAWRENCE J. STAAB
Administrative Patent Judge

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